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Attorney Docket No. 1405.1054



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Kazuki MATSUI, et al.

Application No.: 10/020,248

Group Art Unit: 3622

Confirmation No.: 8732

Filed: December 18, 2001

Examiner: Michael BECKERMAN

For: MERCHANDISING METHOD AND MERCHANDISING DEVICE

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed October 10, 2006, having a shortened period for response set to expire on November 10, 2006. Applicants provisionally elect, with traversal, claims directed to the invention of Group I, which includes claims 1-17, drawn to "systems and methods for targeting products to consumers." Applicants reserve the right to further prosecute without prejudice the non-elected claims 18 and 19, drawn to "a user computer for receiving information", and the related invention.

The restriction is traversed. The Examiner stated that "[i]nventions I and II are related as subcombinations disclosed as usable together in a single combination." and further, that "[S]ubcombination II has separate utility such as browsing the Internet."

However, Applicants submit the following: The computer mentioned in claim 18 is connected to the marketing device, set forth in claim 15 (see claim 18, line 4), for promoting on a network sales. Additionally, the information acquisition device of claim 19 is connected to the computer which executes the marketing method set forth in claim 2 (see claim 19, line 7).

Thus, claims 18 and 19 disclose a computer and a device executing a part of the method mentioned in claim 1, and therefore claims 18 and 19 are directly related to the invention of Group I by incorporation, respectively, to subject matter of the elected claims 15 and 2.

Moreover, insofar as Group I and Group II are concerned, it is believed that claims 1-17 and 18-19 are so closely related that they should remain in the same application. There have been no references cited to show any necessity for requiring a restriction and, in fact, it is believed that the Examiner would find references containing both types of claims in the same field of technology. In fact, the Office Action also clearly indicates that both Groups of claims are in the same class and subclass, i.e. class 705, subclass 14. It is believed, moreover, that evaluation of both sets of claims, amounting to a total of 19 claims with only the 2 additional dependent claims of Group II, would not provide an undue burden upon the Examiner at this time, in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by claims 18 and 19 by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if a restriction were not required.

Upon review of references involved in this field of technology, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

Should any questions remain unresolved, the Examiner is requested to telephone the applicant's attorney.

Respectfully submitted,

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